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In re Application of
TAYLOR
Application No.: 08/604,975
PCT No.: PCT/GB94/00995
Int. Filing Date: 09 May 1994
Priority Date: 25 September 1993
Attorney Docket No.: ITI-169
For: IMPROVEMENTS RELATING TO THE
LINING OF PIPELINES OR
PASSAGEWAYS

DECISION ON PETITION

This is a decision on the "PETITION PURSUANT TO 37 C.F.R. §§ 1.47(b)" filed in the Patent and Trademark Office (PTO) on 25 March 1996.

BACKGROUND

On 09 May 1994, international application No. PCT/GB94/00995 was filed which claimed a priority date of 25 September 1993, and which designated the United States.

On 23 March 1995, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date, and as a result the deadline for entry into the national stage in the U.S. was extended to expire 30 months from the priority date, i.e. 25 March 1996.

On 25 March 1996, a transmittal letter for entry into the national stage in the United States was filed which was accompanied by, inter alia, the basic national fee and the present petition. The petition urges that the application be accepted as filed by the assignee on behalf of the inventor, Mr. Kevan Taylor, under 37 CFR 1.47(b) on the grounds that the inventor cannot be located. The petition was accompanied by, inter alia: a declaration of the inventor executed by the 37 CFR 1.47(b) applicant on behalf of the non-signing

inventor; declarations by Mr. Andrew M. Donlan and Mr. Regan L. Trumper in support of the assertion that the inventor cannot be located; a declaration by Mr. William A. Martin in support of the proprietary interest of the 37 CFR 1.47(b) applicant; and the requisite petition fee.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Items (1), (4), and (6) have been satisfied.

Concerning item (2) above, section 409.03(d) Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made...

A review of the application reveals that the 37 CFR 1.47(b) applicant has not provided a sufficient statement to establish that a diligent effort was made and that the inventor could not be located. The declaration of Mr. Trumper indicates that a single package was sent to Mr. Taylor and that that package was returned by Federal Express along with a paper indicating that the package was undeliverable because the "[r]ecipient did not pick-up package." However, it is not clear what is meant by this notation. Was there an attempt to deliver the package to Mr. Taylor or was the package held by Federal Express at a central location waiting for Mr. Taylor to pick up the package? Would the package have been returned in this manner if Mr. Taylor was merely out of town for a short period of time? Further, a single mailing to Mr. Taylor is not deemed to constitute "a diligent effort" to contact him at his U.S. address.

With regards to the declaration of Mr. Donlan concerning the attempts to contact Mr. Taylor at his U.K. address, Mr. Donlan sets forth that a package was sent to Mr. Taylor on 11 January 1996 and that Mr. Donlan "ha[s] not received any communication whatsoever from Mr. Taylor in relation to this matter." A review of the papers attached to Mr. Donlan's declaration reveals that in addition to the 11 January 1996 package, two

additional letters were sent to Mr. Taylor on 09 February 1996, and 26 February 1996. The declaration of Mr. Donlan does not address what happened to the package and the two letters. Were they returned to Mr. Donlan or were they received by someone at Mr. Taylor's address? The two letters bear an indication that they were sent by "Royal Mail" requesting "a signature on delivery." If the two letters were delivered then who signed for them and what attempts have been made to contact the person accepting the letters for Mr. Taylor to inquire as to their knowledge of Mr. Taylor's whereabouts? Until the above questions are answered it cannot be held that a diligent effort has been made to contact Mr. Taylor at his U.K. address either.

Item (3) above cannot be said to have been satisfied at this time in that the 37 CFR 1.47(b) applicant has provided two last known addresses for Mr. Taylor. It must be asked which of the two is Mr. Taylor's actual last address or does Mr. Taylor maintain residences at both addresses between which he regularly alternates. If the latter is the case, then which of the two addresses would be considered his "primary" residence.

Concerning item (5), the 37 CFR 1.47(b) applicant has not provided sufficient proof that it has sufficient proprietary interest in the invention. Section 409.03(f) of the MPEP states, in part:

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP 324)...

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

A review of the application file reveals that the 37 CFR 1.47(b) applicant is relying on such an employment agreement to establish its proprietary interest. However, in his declaration regarding proprietary interest, Mr. Martin has not established that he has "firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant." Further, the 37 CFR 1.47(b) applicant has not provided a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of the assignee's knowledge and belief, title is in his name as set forth in 37 CFR 3.73 and MPEP §§ 324. Therefore, item (5) also has not been satisfied.

Therefore, in that items (2), (3), and (5) above have not been satisfied, granting of the petition at this time would not be appropriate.

CONCLUSION

For the reasons above, the petition is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

A proper response must include an acceptable showing that the inventor cannot be reached, a clarification of Mr. Taylor's last known address, and an acceptable showing of sufficient proprietary interest as discussed above, or in the alternative, a declaration in compliance with 37 CFR 1.63 executed by Mr. Taylor.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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